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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,498	01/18/2001	Kevin P. Cowan	VI/00-012	6536

21140 7590 03/26/2004

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EXAMINER

DESANTO, MATTHEW F

ART UNIT	PAPER NUMBER
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3763

17

DATE MAILED: 03/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/765,498

Applicant(s)

COWAN ET AL.

Examiner

Matthew F DeSanto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-10,12,13,32,33 and 35-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-10,12,13,32,33 and 35-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12, 16.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 3, 6, 7, 8, 9, 10, 12, 13, 32, 33, 35, 36, 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Aasmul et al. (USPN 6,533,183).

Aasmul et al. discloses a length of material that can be used on syringes that consists of indicators that represent a code when a light beam (electromagnetic energy) is transmitted and reflected from the length of material (notches and grooves) therefore, providing information about the syringe. (Figures 1,2,3,4,5 and Paragraph [0002], [0003], [0011], [0041], and entire reference).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-3, 6-10, 12, 13, 32, 33, 35-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hitchins et al. (USPN 5,944,694) and further in view of Aasmul et al. as applied to claims 1-3, 6-10, 12, 13, 32, 33, 35 - 37 above.

Hitchins et al. disclosed syringe for use with powered injector to inject fluid into a patient comprising a syringe with a plurality of indicators along a length of material of the syringe wall, wherein the syringe comprises a body, a plunger, a mounting flange, a drip flange, but fails to disclose the workings of an optical sensing system that reflects and refracts the light beams to form the code that provides information about the syringe.

Aasmul et al. discloses a length of material that refracts and reflects light to provide information about the syringe.

At the time of the invention it would have been obvious to one of ordinary skill in the art to combine the teachings of Hitchins et al. with Aasmul et al., because Aasmul et al. teaches that adding a length of material comprising notches and grooves, wherein

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the length of material allows light to be reflected and refracted; provides for a more accurate way of coding information on medical devices regardless of what the information might be (Aasmul Column 1, line 55 – Column 2, line 14). It is also well known in the art to use optical coding with regards to refraction and optical sensors to code information. (See USPN 5,461,239)

Response to Arguments

6. Applicant's arguments filed 1/20/04 have been fully considered but they are not persuasive.

7. With regards to Aasmul, the applicant argues that there is no teaching of propagating light through the cartridge and wherein the light that enters the cartridge is detectable. The examiner disagrees with the applicant's interpretation of the claims and the prior art. The claims reads that the length of material is "adapted" to "substantially" propagate light therethrough in a direction "substantially" parallel to the longitudinal syringe axis and therefore reading the claims as broadly as possible the examiner interprets Aasmul reading on the claimed invention. Aasmul has all the structural limitations to perform the functions claimed in the application. Aasmul has the sloped indicators on the outer wall of the cartridge wall wherein the bars are mainly transparent therefore allowing light to be refracted when light passes through the bars, which could be detected. Since the applicant uses "adapted" and "substantially," this broadens the claims, as well as relies on functional language to overcome the prior art, as opposed to structural limitations, especially when this is a device claim.

8. The examiner understands that the prior art is different than the invention, but the applicant fails to claim the invention in the right scope to overcome the prior art. A suggestion would be to include the sensor system in the claim.

9. With regards to the Post-Claim Construction Declarations, the examiner read all three documents submitted and has gained valuable knowledge about the claimed apparatus, but feels at this time that the documents are very specific with regards to how the syringe system works and has many limitations that are not in the claimed invention of this application. Therefore, the examiner has reviewed the documents but feels at this time they are too specific with regards to the sensors and how the syringe system works.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 1-703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew DeSanto
Art Unit 3763
March 22, 2004

BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700